

REMARKS AND INTERVIEW REPORT

Claims 10-29 remain pending; claims 10 and 20 are independent claims. Claims 10 and 20 have been amended; claims 1-9 were previously cancelled. Reconsideration of the application, as amended, is respectfully requested.

I. RESPONSE TO OBJECTIONS.

Interview Report re: Objections and Rule 116 (Specification Amendments)

On October 25, 2007, the undersigned conducted a lengthy interview with Examiner Ferguson. The undersigned thanks the examiner for the time spent on this application. Several follow-on calls also have occurred.

The first subject was the Office's refusal to enter the previous after-final amendment. The Examiner questioned whether the amendments to the drawings and specification included new matter, and the undersigned showed the Examiner where the specification and drawings as filed originally supported each and every amendment. The Examiner stated that the showing met his satisfaction and agreed to enter the amendment.

Following the interview, the Examiner sent an interview report dated November 6, 2007, which did not mention this part of the interview at all. So, in response, the undersigned and his assistant telephoned the Examiner on several occasions, most recently yesterday, to inquire if the amendment could be entered after all, as promised. The Examiner promised to enter the amendment.

Finally, in yesterday's call, the Examiner explained, for the first time, that the problem was that applicants needed to resubmit the amendment, because the Office's electronic system would not allow him to reverse the decision to deny entry of the previous amendment based solely on an oral request (in the interview), but only in response to a petition, request for reconsideration, or resubmitted amendment. In view of the time that has passed while waiting for the Examiner to react to the interview, applicants are resubmitting the amendment, along with more detailed remarks confirming what was explained and agreed to in the interview.

Response to Objections to Drawings

The Office Action objects to the drawings under 37 CFR § 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the drawings do not show the handle being elongated and parallel to the longer axis of the body (claims 13 and 24) and the string of Christmas lights being held in place in the track by the lock (claims 21 and 28). New Figs. 11-17 are proposed to be added to show those features. Accordingly, a new Advisory Action is requested withdrawing the objection.

The new drawings contain no new matter; they merely show subject matter disclosed in the original specification. As explained in the interview, the original specification at page 6, lines 14-20 describes two alternative embodiments, one where the handle portion 14 is oriented perpendicular to the length of body 12 and thus aligned with the track, and the other where the handle portion is oriented along the length of body 12 and thus across the track. The original figures showed the first embodiment; new Figs. 11-16 disclose the second embodiment. Because the modified figures merely confirm the drawings to the text of original page 6 and disclose the same elements with different relative orientations, Figs. 11-16 do not include any new matter.

Fig. 17 discloses a track system attached to the eave of a house. The track and lock 10 are the same as shown in original Fig. 10. The new figure also shows the track system holding a string of lights 100 and the track being fastened to the underside of an eave of a house, which are features disclosed in the original specification's text as well, for example at page 2, lines 10-11. Although that cited sentence discusses prior art systems, the specification makes clear at pages 2-3 generally that a purpose of the inventive system is to replace such conventional designs. Accordingly, Fig. 17 does not include any new matter.

Certain specification amendments have also been proposed. First, the amendment to specification page 2 simply corrects a typographic error; entry would not cause introduction of any new matter. Second, an amendment on page 5 refers to the new drawings, which would not cause entry of new matter. Third, a few additional grammatical or typographic errors are proposed to be corrected on page 5, none of which would introduce new matter. Fourth, the amendment to page 6 identifies the

figures associated with each of the two alternative embodiments above, which, again, merely conforms to the drawings and does not introduce any new matter.

In sum, each and every amendment to the specification and drawings does not introduce new matter. The proposed amendments are in clear condition for entry under Rule 116 because they would put the application in condition for allowance or appeal by virtue of overcoming objections to the specification.

II. RESPONSE TO SECTION 112 REJECTIONS.

Response to Rejection of Independent Claims

Claims 10-29 stand rejected under 35 U.S.C. §112 ¶1 as failing to comply with the written description requirement. The Office Action asserts that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The rejection's basis is believed to be that, if both the width and length of the body are wider than the slot, as in the claims before being amended, it would not be possible to insert the lock into the slot.

The rejection is believed overcome, because it is respectfully submitted that the subject matter of amended claims 10-29 is described in the specification.

Each of claims 10 and 20 (as amended) recites "wherein the narrower axis of the body is *no wider* than the slot of the slotted track." (Emphasis added.) The word "no" had been inadvertently omitted from Claims 10 and 20. It is stated in the specification (at page 5, line 12) that, "It is critical that the body 12 of the lock 10 ... have a length that is substantially equal to the width of the track system..." and (at page 6, line 9) that, "The lock 10 is inserted into the track, adjacent to the item to be secured." The latter condition makes it clear that the narrower axis of the body should be no wider than the width of the slot, because the wider axis (being substantially equal to the width of the track) is clearly wider than the slot. The specification clearly indicates that applicant has possession of the invention that includes the narrower axis of the body being no wider than the width of the slot. Claims 10 and 20 therefore satisfy the written description requirement of 35 U.S.C. §112.

Response to Rejection of Dependent Claims

The Office Action contains further rejections under §112 ¶1 with respect to certain dependent claims. Applicants respectfully submit that the amendments to the independent claims cure those rejections as well.

Each of claims 14, 18, and 27 recites “wherein the body comprises two rounded edges at opposite corners of a generally box-shaped body, which edges are parallel to the neck.” It is stated in the specification (at page 5 line 18) that, “Further, at least one, preferably two edges 15 of the body are rounded in order to allow the body 12 to more smoothly rotate within the track of a track system.” The referenced rounded “edges 15” are shown in the figures, such as Fig. 5, as being the edges generally parallel to the neck (as opposed to the edges on the top or bottom surfaces of the body). Claims 14, 18, and 27 therefore satisfy the written description requirement of 35 U.S.C. §112.

Each of Claims 16 and 25 recites “wherein the body has two opposite sides not parallel to each other, which sides are generally parallel to the neck.” It is stated in the specification (at page 5 line 15) that, “Sides 13 are angled relative to each other such that the portion of the body that attached to the downward portion 18 is wider than its opposite side.” The referenced angled “sides 13” are shown in the figures as being the sides generally parallel to the neck (as opposed to the sides on the top or bottom surfaces of the body). Claims 16 and 25 therefore satisfy the written description requirement of 35 U.S.C. §112.

Interview Report re: Section 112 Rejection and Rule 116 (Claim Amendments)

The claim amendments would place the application in condition for allowance or in better form for consideration on appeal. That is true because entry of the amendments would overcome the rejection under Section 112. Therefore, entry of the amendments is amply justified under 37 C.F.R. §1.116.

In the interview in October, the Examiner seemed to acknowledge this point and agree to enter the amendment.

The Advisory Action (issued before the interview) states that the claim amendment “presents a change in claimed structural features and a change in scope of the claims, and thus [would] require further search and/or consideration.” Clearly,

further consideration would be needed, but that is not a reason to reject entry of the claim amendment: The correct issue is whether further searching would be required as a result of the amendment. Clearly, it would not.

The change merely fixes a typographic error. Apparently, the Examiner had even noticed that the claim had a typographic error, because he pointed it out through the Section 112 rejection. So, the Examiner's search plainly addressed the claim without being fooled by the typographic error.

The nature of the art rejections described in the final Office Action confirms that the Examiner apparently adjusted for the typographic error. The art as applied seemed to match the claim as it should have been written, rather than as it was presented with the typographic error – because each item of art applied in the rejection showed a body “no wider than the slot” (the corrected language), and none of the art references showed a body “wider than the slot” (the original language).

Accordingly, it is plainly incorrect that any further search would be required on account of the amendment. (Applicants would have no problem if the Office needed supplemental searching before allowance, but that does not require denial of entry of the amendment.) Because the statement in the Advisory Action that further searching would be required if applicants were allowed to fix a typographic error is plainly in error, applicants respectfully requests entry of the claim amendments under Rule 116.

III. RESPONSE TO ART REJECTIONS.

Rejections under 35 U.S.C. §102

1. Claims 10-13, 17, 20-24, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Moreland (U.S. Patent 6,364,508), an earlier patent to the same inventor cited as prior art (referenced as “Moreland” herein).

The rejection is believed overcome because claims 10-13, 17, 20-24, and 26 are neither anticipated by Moreland nor obvious in light of Moreland for at least the following reasons.

Each of claims 10 and 20 recites “wherein the body is sized ... to fit *snugly* within the interior of the slotted track when the narrower axis is parallel to the track” (emphasis added). Moreland does not disclose a body “sized to fit snugly” within a

slotted track in any orientation. The Office Action does not identify any portion or element disclosed by Moreland that states or shows such a body (although the Office Action contains citations to specific portions or features of the references with respect to other elements believed to match the claims).

In Moreland, crossbar 82 is integrally formed with slide mount 80 to form a kind of T-shaped structure, which fits into the slot of a track system. The intent is to enable the structure to slide along the track by retaining crossbar 82 within the track (*see* Fig. 3; column 6 lines 1-15 and elsewhere). Nowhere does Moreland disclose or suggest that the body (*i.e.*, crossbar 82 or the T-shaped structure as a whole) ever fits snugly within the track. To the contrary, a snug fit would prevent the slide mount from sliding along the track. Nor is there any reason why it would be desirable to modify Moreland so as to fit the crossbar snugly within the track, because such a snug fit would render Moreland's device unsuitable for its intended purpose (*i.e.*, to slide along the slotted track).

Because not all elements and limitations of claim 10 or 20 are disclosed by Moreland, rejection under 35 C.F.R. §102 is improper. Withdrawal of the rejection is respectfully requested.

2. Claims 10-20 and 22-27 also stand rejected under 35 U.S.C. §102(b) as being anticipated by Onishi (U.S. Patent 6,588,711).

The rejection is believed overcome because it is respectfully submitted that claims 10-20 and 22-27 are neither anticipated by Onishi nor obvious in light of Onishi for much the same reasons. As noted above, each of the independent claims requires that the body be "sized to fit snugly within" the slotted track. Onishi does not disclose that element any more than does Moreland.

Onishi discloses a fixture for fastening to a slotted rail that includes, *inter alia*, a threaded retaining plate (*i.e.*, "fastening nut") 1, a bracket 30/31/33, and a screw 4. Turning the screw apparently causes the retaining plate to move along the bracket, to enable tightening the fixture against the rail. The threaded retaining plate 1 is identified in the Office Action as corresponding to the body of the lock recited in the claims, and the portion 33 of the bracket is thought to correspond to the neck recited in the claims.

Nowhere does Onishi disclose or suggest that the retaining plate fits snugly within a slotted rail or track. Although the fixture of Onishi can be *fastened against* the slotted rail by tightening the screw (assuming the retaining plate is properly positioned), that is not the same as being *sized to fit snugly* within the slotted rail.

Like Moreland, modifying Onishi to have the retaining plate fit snugly within the slotted track would be inconsistent with Onishi's plain intent to allow the plate to slide along the slotted track. Indeed, in Onishi, such a modification would make that inventor's whole system of tightening the fixture against the rail with a screw unnecessary. Moreover, Onishi specifically teaches that a purpose of his invention is to prevent contact between the retaining plate and the rail during tightening of the screw into the retaining plate (e.g., column 2 lines 53-60), which purpose is contrary to the claimed feature of having a snug fit between the body and the rail.

Further, Onishi does not disclose that the bracket and retaining plate are integrally formed. Each of claims 10 and 20 recites "a neck *formed integrally* with the body at one end and *formed integrally* with the handle at the other end" (emphasis added).

Onishi discloses that the retaining plate is intended to slide along the portion 33 of the bracket. The retaining plate must slide along the portion 33 of the bracket to enable fastening of the fixture to the slotted rail. The bracket and retaining plate cannot be integrally formed and also provide the required movement. There is no indication that the fixture of Onishi can or should be modified to be integrally formed, because such integral formation would render the fixture of Onishi unsuitable for its intended purpose.

Because not all elements and limitations of claim 10 or 20 are disclosed by Onishi, rejection under 35 C.F.R. §102 is improper. Withdrawal of the rejection is respectfully requested.

3. In view of the above distinctions based on the independent claims, it is not considered necessary to discuss further distinctions arising from select dependent claims.

Interview Report Regarding Art Rejections

In the interview, as summarized by the Examiner's interview report: "Examiner notes that the phrase 'to fit snugly' used in claims 10 and 20 has been interpreted as broadly as reasonable to be constituted by a body which fits closely to the interior walls of the track. Examiner notes that a frictional engagement between the one-piece lock and the interior walls of the track has not been positively claimed. Examiner suggested adding structural limitations to positively define the interior walls defining the cavity of the track and the structural cooperative relationship between the one-piece lock and the interior walls and the slot of the track."

The interview report as issued by the Office does not record the undersigned's response to the above comments. The undersigned respectfully requests that the examiner reconsider the art rejections in view of the following points, which were explained in the interview.

First, the phrase "to fit snugly" is not found in the claims all by itself. Claim 10 states that "the body" must be "sized ... to fit snugly within the interior of the slotted track when the narrower axis is parallel to the track."

With all due respect, it is not a reasonable interpretation of this claim language to isolate the phrase "to fit snugly" by divorcing it from its context and interpret it without consideration of the accompanying "sized to fit" limitation.

Put another way, neither of the cited art references disclose or suggest any sizing of the body such that it fits snugly in the track:

(a) The Moreland reference does not disclose any body that "fits closely to the interior walls of the track," which is the definition adopted by the examiner in the interview – rather, it discloses a body that fits loosely in the track, because it slides along the track. That art rejection must be withdrawing in any event.

(b) The Onishi reference discloses a fixture that can be *fastened against* the slotted rail by tightening a screw (assuming the retaining plate is properly positioned). Apparently the examiner assumes (using a broad definition of "snug") that tightening the screw will cause the body "to fit snugly" against the slotted rail. However, that reference does not disclose a body sized to fit snugly within the slotted rail.

Second, the examiner's suggestion to add "structural limitations" with respect to the track, while helpful and appreciated, does not mean that applicant is not entitled to the claims presently pending. Indeed, claim 20, for one, does contain structural limitations to both the track and the body.

Claim 10, by contrast, is intended to claim just the body, which – although sized to be suitable for engagement with the track – does not require that the track also to be sold as part of the same kit to result in infringement. It should be perfectly permissible to present claim 10 with a claim that includes a structural limitation of the body that allows it to engage the track, without having to claim the track as part of the combination.

The Examiner "notes that a frictional engagement between the one-piece lock and the interior walls of the track has not been positively claimed." This is not exactly correct. The term "frictional engagement" is just a different way of expressing the concept of "sized to fit snugly." The latter term is "positively claimed" in the independent claims. It is not clear whether the examiner perceives some difference in scope between the two. In applicant's view, the term "sized to fit snugly" (in one direction) implies that the body must be sized so as to engage the interior walls of the track. Thus, these are just two ways of expressing what seems to be a similar concept.

The language implied by the Examiner's comment may be adopted in a continuation. Nevertheless, applicant prefers to express the concept using the language chosen by the undersigned attorney, and, again, the current language is under consideration and must be evaluated on its merits, whether or not it is how the Examiner might choose to write the claim.

Conclusion

In view of the above, it is respectfully submitted that claims 10-29 are in condition for allowance. Reconsideration of the rejections is respectfully requested. Entry of the amendment is required and respectfully requested. Allowance of claims 10-29 at an early date is earnestly solicited.

Respectfully submitted,
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